

### **REMARKS**

This Amendment is filed in response to the Office Action mailed May 28, 2008. In this Amendment, claims 10, 18 and 37 are amended and claims 11-17, and 38-41 are unchanged. Following entry of this amendment, claims 10-18 and 37-41 shall be pending.

In the Office Action, claim 18 is objected to because of an informality, and claims 10-18 and 37-41 have been rejected based on prior art grounds. For the reasons set forth below, these rejections are hereby traversed.

#### **I. INFORMATION DISCLOSURE STATEMENT**

With regard to the IDS of April 26, 2004, citation A28 is a typographical error. The correct patent number is 5,837,007. A corrected IDS statement is being submitted with this Amendment.

#### **II. CLAIM OBJECTION**

The Examiner objected to claim 18 because claim 18 recites a method but depends from a non-elected claim 9. Claim 18 has been amended to depend from claim 10 as suggested by the Examiner. It is believed that this claim remains a part of the previously elected invention.

#### **III. REJECTIONS UNDER 35 U.S.C. SECTION 102**

Claims 10-18 and 37-41 are rejected under 35 U.S.C. Section 102(b) as being anticipated by International Publication No. WO 01/26585 to Altman ("*The Altman Patent*"). For at least the reasons set forth below, it is submitted that these prior art rejections should be withdrawn and the pending claims allowed.

*The Altman Patent* cannot be properly relied upon as anticipating the invention as recited in amended claim 10. For example, *The Altman Patent* fails to at least show

migration of an implant causing a circumferential tissue response of said pulmonary vein that treats said atrial arrhythmia as recited.

*The Altman Patent* describes the use of a stent which is deployed at the ostium of the pulmonary vein. Unlike the present invention as recited in claim 10, the Altman stent simply presses against the ostium without causing tissue damages. For example, page 8, lines 6-11 states that, "...placement of the stent alone can act to isolate the target pulmonary vein from the atrial conduction and excitation process. The primary advantage of this method is that no tissue is damaged."

As the Examiner points out, the Altman stent can have barbs to help fasten the stent to the pulmonary wall. However, these barbs are related to maintaining the position of the stent only and NOT to the actual treatment of atrial arrhythmia such as causing a tissue response of the pulmonary vein that treats atrial arrhythmia. Further, any penetration of the tissue by the barbs would only be at the immediate location of the barb itself and therefore would not create a circumferential tissue response of the pulmonary vein.

Thus for at least this reason, *The Altman Patent* fails to anticipate claim 10. It is also submitted that *The Altman Patent* does not render the invention obvious.

Turning to claims 11-18, these claims depend from claim 10 and thus for at least the above reasons are also novel and unobvious over the cited prior art. However, these claims further limit the claimed invention and thus are separately patentable over the cited prior art.

The Examiner is further reminded that, as stated in MPEP Section 2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)."

While the Examiner has apparently described *The Altman Patent* with regard to at least some of the elements of claim 10, the Examiner has apparently ignored many, if not all of the elements from dependent claims 11-18. For example, the Examiner is

silent to the implant migrating through the wall of the pulmonary vein (claim 11), the formation of scar tissue (claim 12), delivering a compressed stent (claim 13), expanding a spatial anchoring section of an implant (claim 14), allowing a conduction block inducing section of the implant to expand in to the wall (claim 15), engaging retention surfaces in the wall of the pulmonary vein (claim 16), and delivering an elongated implantable strip to the target site (claim 18). Thus the Examiner has failed to make a *prima facie* case of anticipation.

**If the Examiner wishes to maintain the anticipation rejection of claims 11-18, it is requested that the Examiner provide a proper *prima facie* case of anticipation pointing out each and every element that is present in the prior art.**

*The Altman Patent* cannot be properly relied upon as anticipating the invention as recited in amended claim 37. For example, *The Altman Patent* fails to at least show initiating the formation of circumferential scar tissue in the ostial region of the pulmonary vein with a second component of the implant, as recited.

*The Altman Patent* describes the use of a stent which is deployed at the ostium of the pulmonary vein. Unlike the present invention as recited in claim 37, the Altman stent simply presses against the ostium without causing tissue damages. For example, page 8, lines 6-11 state that, "...placement of the stent alone can act to isolate the target pulmonary vein from the atrial conduction and excitation process. The primary advantage of this method is that no tissue is damaged."

As the Examiner points out, the Altman stent can have barbs to help fasten the stent to the pulmonary wall. However, these barbs are related to maintaining the position of the stent only and NOT to the actual treatment of atrial arrhythmia such as initiating the formation of circumferential scar tissue. Further, any penetration of the tissue by the barbs would only be at the immediate location of the barb itself and therefore would not create circumferential scar tissue. In fact, *The Altman Patent* fails to even teach the creation of scar tissue by the Altman stent and further teaches away the creation of such scar tissue (see page 8 lines 6-22).

Thus for at least this reason, *The Altman Patent* fails to anticipate claim 37. It is also submitted that *The Altman Patent* does not render the invention obvious.

Turning to claims 38-41, these claims depend from claim 37 and thus for at least the above reasons are also novel and unobvious over the cited prior art. However, these claims further limit the claimed invention and thus are separately patentable over the cited prior art.

The Examiner is further reminded that, as stated in MPEP Section 2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)."

While the Examiner has apparently described *The Altman Patent* with regard to at least some of the elements of claim 37, the Examiner has apparently ignored many, if not all of the elements from dependent claims 38-41. For example, the Examiner is silent to causing the second component to migrate into ostial region tissue (claim 38), expanding the first component to a size that causes an expansion force on the internal walls of the pulmonary vein (claim 39), causing the second component of the implant to migrate into the ostial region at a faster rate than the first component of the implant (claim 40), and abutting the implant against a bifurcation of the pulmonary vein (claim 41).

**If the Examiner wishes to maintain the anticipation rejection of claims 11-18, it is requested that the Examiner provide a proper *prima facie* case of anticipation pointing out each and every element that is present in the prior art.**

**CONCLUSION**

In view of the foregoing, it is submitted that pending claims 10-18 and 37-41 are now in condition for allowance. Hence, an indication of allowability is hereby requested.

If for any reason direct communication with Applicants' attorney would serve to advance prosecution of this case to finality, the Examiner is cordially urged to call the undersigned attorney at the below listed telephone number.

The Commissioner is authorized to charge any additional fee which may be required in connection with this Amendment to deposit account No. 50-2809.

Respectfully submitted,

Dated: September 29, 2008



Charles E. Fredericks  
Registration No. 51,703

INSKEEP INTELLECTUAL PROPERTY GROUP, INC.  
Inskeep Intellectual Property Group, Inc.  
2281 W. 190th Street, Suite 200  
Torrance, CA 90504  
Phone: 310-755-7800  
Fax: 310-327-3466

*Customer No. 37,374*